

REMARKS

Applicants submit this Amendment in reply to the non-final Office Action mailed March 24, 2008. Prior to this Reply, claims 43-84 were pending. By this amendment, Applicants have cancelled claims 52 and 59-61. Thus, claims 43-51, 53-58, and 62-84 remain pending in this application, of which claims 43 and 84 are independent.

In the Office Action, the Examiner objected to the drawings under 37 CFR 1.83(a) as failing to show every feature of the invention specified in the claims; rejected claims 53 and 70 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention; rejected claims 43, 46-49, 54-56, 73, 74, 76, 77, 79, 80, and 84 under 35 U.S.C. § 102(b) as being anticipated by U.S. Pat. No. 6,268,787 ("Onizuka"); rejected claims 43-45 under 35 U.S.C. § 103(a) as being unpatentable over DE 2710620 ("Siewerth") in view of Onizuka; rejected claims 57, 68, 69, 78, and 81 under § 103(a) as being unpatentable over Onizuka; rejected claim 58 under § 103(a) as being unpatentable over Onizuka in view of U.S. Pat. No. 3,222,449 ("Garwin"); rejected claims 70 and 71 under § 103(a) as being unpatentable over Onizuka in view of U.S. Pat. No. 4,447,795 ("Sefko"); and provisionally rejected claims 43-45, 47, 50, 51, 58-67, and 82 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 29, 30, 36, 38, 40-42, 44, and 51 of copending U.S. App. No. 10/530,520 (issued as U.S. Pat. No. 7,365,269) in view of U.S. Pat. No. 5,709,249 ("Okada").

In this Reply, Applicants have amended independent claims 43 and 84, amended dependent claims 53, 62-67, 70, 72, 73, 76, and 82, and cancelled claims 52 and 59-61 without prejudice or disclaimer. Independent claim 43 now recites, among other things:

An electrical power transmission line comprising: . . . at least one shielding element comprising a plurality of shielding modules arranged side by side, each shielding module made of at least one ferromagnetic material arranged in a radially outer position with respect to said at least one cable for shielding the magnetic field generated by said cable, each of said plurality of shielding modules comprising a base and a cover . . .

Independent claim 84 has been similarly amended. Support for these amendments can be found in Applicants' specification at least at page 11, lines 2-11 and Figures 1, 3, 6, and 7.

Applicants respectfully traverse all pending rejections for at least the reasons outlined below.

Objections to the Drawings

In the Office Action, the Examiner objected to the drawings under 37 CFR 1.83(a) as failing to show every feature of the invention specified in the claims. Specifically, the Examiner asserted that specific features recited in claims 52, 59, and 60 are not shown in the drawings. However, by this amendment, Applicants have cancelled claims 52, 59, and 60. Thus, the Examiner's concerns regarding the drawings are moot.

Accordingly, Applicants respectfully request the reconsideration and withdrawal of this objection.

Rejections Under 35 U.S.C. § 112, Second Paragraph

In the Office Action, the Examiner rejected claims 53 and 70 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and

distinctly claim the subject matter which Applicants regard as the invention. According to the Examiner, claim 53, line 1 should be amended to recite "claim 50" as opposed to "claim 47" and claim 70 should not recite trademarks or trade names to identify or describe a particular material or product. In response, Applicants note that, by this Reply, claim 53 has been amended as suggested and the trademarks recited in claim 70 have been deleted. Thus, the Examiner's rejections under § 112 are moot.

Accordingly, Applicants respectfully request the reconsideration and withdrawal of this rejection.

Rejections Under 35 U.S.C. § 102(b)

The Examiner also rejected claims 43, 46-49, 54-56, 73, 74, 76, 77, 79, 80, and 84 under 35 U.S.C. § 102(b) as being anticipated by Onizuka. In order to properly establish that Onizuka anticipates Applicants' claimed invention under 35 U.S.C. § 102, every element of the claims in issue must be found, either expressly or described under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." M.P.E.P. § 2131 (quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989)).

Onizuka fails to disclose every element of Applicants' claimed invention, as amended. Amended independent claim 43 recites, among other things:

at least one shielding element comprising a plurality of shielding modules arranged side by side, each shielding module made of at least one ferromagnetic material arranged in a radially outer position with respect to said at least one cable for shielding the magnetic field generated by said cable, each of said plurality of shielding modules comprising a base and a cover

Independent claim 84 has been amended to recite similar features. Nowhere does it appear that Onizuka discloses or suggests a “shielding element comprised of a plurality of shielding modules arranged side by side . . . each of said plurality of shielding modules comprising a base and a cover.” To the contrary, Onizuka discloses only a ferrite-core casing comprising a single shielding element encased in an outer housing. The reference does not teach “a plurality of shielding modules arranged side by side.”

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of independent claims 43 and 84 based upon Onizuka under 35 U.S.C. § 102(b). Moreover, claims 46-49, 54-56, 73, 74, 76, 77, 79, and 80 depend from claim 43 and, thus, contain all the elements and limitations thereof. As a result, the Examiner should also withdraw the rejections of dependent claims 46-49, 54-56, 73, 74, 76, 77, 79, and 80 under 35 U.S.C. § 102(b) at least due to their corresponding dependence from independent claim 43.

Rejections Under 35 U.S.C. § 103(a)

Applying 35 U.S.C. § 103(a), the Examiner rejected claims 43-45 as being unpatentable over Siewerth in view of Onizuka; claims 57, 68, 69, 78, and 81 as being unpatentable over Onizuka; claim 58 as being unpatentable over Onizuka in view of Garwin; and claims 70 and 71 as being unpatentable over Onizuka in view of Sefko. Applicants respectfully traverse each of these claim rejections because the Office Action has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” M.P.E.P. § 2142. Moreover, “in formulating a

rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it [is] necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

A *prima facie* case of obviousness has not been established because, among other things, none of Siewerth, Onizuka, Garwin, Sefko, nor their combination, teaches or suggests each and every feature of Applicants' claims. As outlined previously herein, Onizuka does not teach or suggest at least “a plurality of shielding modules arranged side by side,” as recited in independent claim 43. Further, none of Siewerth, Garwin, or Sefko teach or suggest such features. Thus, the Examiner's citation of these additional references fails to cure the deficiencies of Onizuka.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of independent claim 43 based upon Siewerth and Onizuka under 35 U.S.C. § 103(a). Moreover, claims 44, 45, 57, 58, 68, 69-71, 78, and 81 depend from claim 43 and, thus, contain all the elements and limitations thereof. As a result, the Examiner should also withdraw the rejections of dependent claims 46-49, 54-56, 73, 74, 76, 77, 79, and 80 based upon Siewerth, Onizuka, Garwin, and Sefko under 35 U.S.C. § 103(a) at least due to their corresponding dependence from independent claim 43.

Provisional Rejections on the Ground of Nonstatutory
Obviousness-Type Double Patenting

The Examiner also provisionally rejected claims 43-45, 47, 50, 51, 58-67, and 82 on the ground of nonstatutory obviousness-type double patenting as being unpatentable

over claims 29, 30, 36, 38, 40-42, 44, and 51 of copending U.S. App. No. 10/530,520 (issued as U.S. Pat. No. 7,365,269) in view of Okada.

In response, Applicants disclaim, as set forth in the Terminal Disclaimer filed herewith, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term of U.S. Pat. No. 7,365,269.

Accordingly, Applicants request the Examiner reconsider and withdraw the provisional rejection of claims 43-45, 47, 50, 51, 58-67, and 82 on the ground of nonstatutory obviousness-type double patenting.

Claim Scope

It is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification, abstract, and/or shown in the drawings. Rather, Applicants believe that they are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 17, 2008

By:

Benjamin D. Bailey
Reg. No. 60,539

